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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,890	01/07/2004	Richard H. Bossi	038190/269130	4562
826	7590	05/10/2006		EXAMINER
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			CHAPMAN JR, JOHN E	
			ART UNIT	PAPER NUMBER
				2856

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/752,890	BOSSI ET AL.
	Examiner John E. Chapman	Art Unit 2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,10-12,20,23 and 24 is/are rejected.
- 7) Claim(s) 2-9,13-19,21 and 22 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/14/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2006 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 12 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy et al. (6,722,202).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another."

Kennedy et al. discloses a driven probe (actuating portion) 14 having at least one magnet 18, and a tracking probe (inspecting portion) 16 having an inspection sensor 20 and at least one magnet 18.

Regarding claim 12, the inspection sensor may comprise a camera (column 6, line 67).

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this

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rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The only difference between the claimed invention and the prior art consists in the type of the ultrasonic transducer employed. It is well known in the art to use a laser ultrasonic transducer in order to provide a non-contact arrangement and avoid having to provide a coupling medium. Accordingly, it would have been obvious to one of ordinary skill in the art to use a laser ultrasonic transducer in the inspection device of Kennedy et al. in order to provide a non-contact arrangement and avoid having to provide a coupling medium.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al. in view of Clark et al. (4,010,636).

The only difference between the claimed invention and the prior art consists in providing a positional encoder to monitor the positioning of the probe. Kennedy et al. teach recording the relative position of the tracking probe (column 9, lines 56-60). It is well known in the art to provide a position encoder in order to monitor the position of a probe, as taught by encoder 92 of Clark et al. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the probe 14 of Kennedy et al. with a positional encoder in order to monitor the relative position of the probes on the surface of a structure 12.

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7. Claim 23 and 24 are rejected under 35 U.S.C. 103(a) as being obvious over Kennedy et al. in view of Bashyam. (5,343,750).

The only difference between the claimed invention and the prior art consists in the inspecting a feature of the structure extending from the second surface of the structure. It is well known in the art to inspect a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam. Accordingly, it would have been obvious to one of ordinary skill in the art to provide the tracking probe 16 of Kennedy et al. with an ultrasonic transducer for inspecting a complex surface, such as a flange inner fillet 28 in Fig. 3 of Bashyam.

8. Claims 2-9, 13-19, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The declaration under 37 CFR 1.132 filed January 26, 2006 is insufficient to overcome the rejection of claims 1, 10-12, 20, 23 and 24 based upon Kennedy et al. (6,722,202) as set forth in the last Office action because it does not clearly state that Mr. Kennedy alone conceived or invented the subject matter disclosed in U.S. Patent No. 6,722,202 and relied on in the rejection of the claims. See *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982). While Mr. Kennedy declares that he is “the inventor that conceived of the common subject matter that is disclosed and claimed in both the ‘202 patent and the ‘890 application,” it is not clear that Mr. Kennedy asserts that he is the sole inventor in this regard. Furthermore, it is not clear what is meant by “the common subject matter that is disclosed and claimed in both the ‘202 patent and

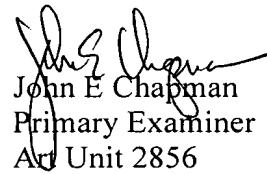
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the '890 application." It is not clear what disclosure the patent and application have in common, since the application does not repeat any portion of the patent, other than three paragraphs in the "Background of the Invention." Furthermore, it is not clear what it means for the claims in the patent and application to have "common subject matter." At issue is (1) whether Mr. Kennedy is the sole inventor of the subject matter of the rejected claims (i.e., claims 1, 10-12, 20, 23 and 24) in the application and (2) whether he alone conceived or invented the subject matter disclosed in the patent and relied on in the rejection of the claims. An unequivocal declaration by Mr. Kennedy under 37 CFR 1.132 stating (1) that he is the sole inventor of the subject matter of the rejected claims in the application and (2) that he alone conceived or invented the subject matter disclosed in the patent and relied on in the rejection of the claims would receive favorable consideration.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John E. Chapman whose telephone number is (571) 272-2191. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John E Chapman
Primary Examiner
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